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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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COOK, P	ART UNIT	PAPER NUMBER
		5

1614

DATE MAILED: 07/02/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on \_\_\_\_\_

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-12, 17-18 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-12, 17-18 is/are rejected.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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The disclosure is objected to because of the following informalities:

On page 11 should not the International Patent Application be identified as

✓ PCT/SE96/01361?

Appropriate correction is required.

Claims 1-12, 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the recitation the following recitations are not clear:

Does "in oil form in the final composition" mean that the composition as claimed is not the "final" composition?

(ii) requires only one surfactant, but "together present" implies that more than one

✓ surfactant is required.

✓ "water up to 100% by weight" implies that no water is required and that nothing else is present in the composition.

cl 10,12 The intent of the recitation "of one claims 1-7" in claims 8-10, 12 is not clear.

It is not seen that an effective amount is used in the method of claim 17.

No antecedent basis is seen in claim 1 for the recitation in claims 5, 6 and 7 "the active ingredient".

Claim 12 contains the trademark/trade names Lutrol F68 and Lutrol F127. Where a

✓ trademark or trade name is used in a claim as a limitation to identify or describe a particular

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material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe two surfactants and, accordingly, the identification/description is indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-12 and 17-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 241 178 and 4,780,320.

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Claims 1-6, 8-12 and 17-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 241 178 and 4,780,320.

The references disclose pharmaceutical gels comprising the instant anesthetics and instant surfactants, the instant method of use and method of preparation.

The claims appear to differ over the references in requiring a taste masking agent and in the length of time the composition is left in the mouth. However, it is well-known to one skilled in the art that taste masking agents are required for compositions that are intended for oral use. Furthermore, it would be obvious to one of ordinary skill in the art that periodontal scaling can cause pain for which relief would be needed after the scaling.

wd  
Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by CA123:152960.

? - 219 put in  
further search  
Claims 1, 5-6, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by

CA105:11993.

wd further d9  
Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by WPIDS AN 94-  
351141.

Claims 1, 3-6, 9-11, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by

wd  
5,635,540.

wd as amended  
Claims 1-4, 8-12, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
EP 455 396.

The reference discloses thermo-reversible pharmaceutical gel compositions comprising the instant surfactants and how to prepare them. The claims appear to differ over the references in

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requiring a taste masking agent and being used to treat pain associated with periodontal scaling. However, the reference discloses (page 8) that the particular drug used is the type which a patient would require for pharmacological treatment of the condition from which the patient is suffering. It would be obvious to one of ordinary skill in the art to use a taste masking agent in composition used to treat pain in the mouth. Additionally, it would be obvious that treatment for pain would include pain associated with periodontal scaling.

Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

5,589,180.

The claim differs over the reference in appearing to be a gel. However, the references further disclose that they can be employed in gel form.

Claim 1, 8-10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

5,612,052.

The claims appear to differ over the references in being to a method of treatment of pain associated with periodontal scaling. However, it would be obvious to one of ordinary skill in the art to use an anesthetic for treatment for pain, including pain associated with periodontal scaling.

Any inquiry concerning this communication should be directed to Examiner Cook at telephone number (703) 308-4724.

*Rebecca Cook*

REBECCA COOK  
PRIMARY EXAMINER  
GROUP 1200

July 1, 1998